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The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 20

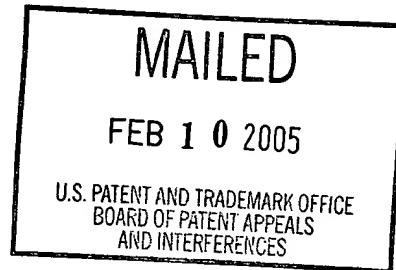
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EUGENE M. BETZ, MAHESH P. VANNAVADA,
LUO-JEN CHIANG, JAMES E. THAISZ and
KAREN A. PAPIERNIAK

Appeal No. 2004-0955
Application No. 09/472,852

ON BRIEF



Before KRASS, GROSS and MACDONALD, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

Decision on Appeal

This is a decision on appeal from the final rejection of claims 1-21.

The invention is directed to a computer implemented method of capturing and recording changes to an electronic data warehouse, wherein data discovery information is obtained from a user, a portion of the data warehouse is documented in a System

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of Record (SOR) document using the obtained data discovery information, and a user customized document is generated incorporating at least a portion of the discovery information recorded in the SOR database.

Independent claim 1 is reproduced as follows:

1. A computer implemented method of capturing and recording changes to an electronic data warehouse or data mart, comprising:

soliciting a user for data discovery information defining data and sources of the data for a data warehouse or data mart;

documenting at least a portion of the data warehouse or data mart in an SOR (System of Record) document using the discovery information collected from the user as a result of said soliciting step; and

generating a user customized document incorporating at least a portion of the discovery information recorded in the SOR database.

The examiner relies on the following references:

Mukhopadhyay et al. (Mukhopadhyay) 6,032,158 Feb. 29, 2000
(filed May 2, 1997)

Bair et al. (Bair) 6,067,523 May 23, 2000
(filed Jul. 3, 1997)

Claims 1-21 stand rejected under 35 U.S.C. § 103 as unpatentable over Mukhopadhyay in view of Bair.

Reference is made to the brief and answer for the respective positions of appellants and the examiner.

OPINION

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). To reach a conclusion of obviousness under § 103, the examiner must produce a factual basis supported by a teaching in a prior art reference or shown to be common knowledge of unquestionable demonstration. Our reviewing court requires this evidence in order to establish a prima facie case. In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). The examiner must not only identify the elements in the prior art or that knowledge generally available to one of ordinary skill in the art would lead the individual to combine the relevant teachings of the references. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

With regard to independent claim 1, the examiner contends that Mukhopadhyay teaches the claimed subject matter but for "generating a user customized document..." In particular, the examiner refers to the abstract and Figures 1 and 2 of the reference for a teaching of a computer implemented method of capturing and recording changes to an electronic data warehouse

or data mart. The examiner refers to column 4, lines 39-48, of Mukhopadhyay for the claimed step of "soliciting a user for data discovery information defining data and sources of the data for a data warehouse or data mart," contending that the user designates a source table to be a primary source table, and that "defining data" corresponds to what data should be captured from the source tables of the operational database elements 201-202, as detailed in column 4, lines 9-12 (answer-page 4). Then, the examiner identifies column 4, lines 58-67, and column 5, lines 1-5, as well as column 6, lines 61-67, of the reference for a teaching of the claimed step of "documenting at least a portion of the data warehouse or data mart in an SOR (System of Record) document using the discovery information collected from the user as a result of said soliciting step," explaining that SOR corresponds to Mukhopadhyay's table 1 since that table is specifically directed to various systems of records.

After noting the deficiency of Mukhopadhyay, the examiner turns to Bair, specifically figures 3-4, and column 8, lines 32-36 and 58-67, for a teaching of "generating a user customized document," wherein the customized document is said to correspond to an individual patient's record in Bair.

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The examiner concludes that it would have been obvious to incorporate the teachings of Bair into capturing and propagating changes from an operational database to data marts of Mukhopadhyay

because they both are directed to data storing in one or more databases, more specifically Mukhopadhyay teaches capturing and propagating changes made upon an operational database to one or more target data marts [see col. 1, line 7-12], while Bair is directed to creating displaying, reports for aggregating data from patient treatment results, more specifically optimization system and method for integrating patient data, electronically communicating selected information to a data collection center for amassing a database of behavioral treatment, displaying treatment goals and like as detailed in col 2, line 52-58]. It would have been obvious...to combine the references because that would have allowed users of Mukhopadhyay's capturing and propagating changes from an operational database to data marts to control which relative combinations of individual patient's database satisfies his or her needs as suggested by Bair...[col 3, see 41-46] [answer-pages 4-5].

We will not the sustain the rejection of independent claim 1, or of claims 2-21, dependent thereon, under 35 U.S.C. § 103 because, in our view, the examiner has not established a prima facie case of obviousness with regard to the instant claimed subject matter.

Even assuming that the examiner is correct in the interpretation of Mukhopadhyay, viz., that the reference discloses the claimed subject matter but for the step of

"generating a user customized document . . .," this claimed step is allegedly the improvement over the prior art, as appellants explain at page 3 of the specification, i.e., data warehouse/customer engagement was known, but it is the documenting of the engagement process used in creating and maintaining the data warehouse which appellants offer as an improvement.

Thus, the issue before us is whether Bair provides for this claimed improvement step and, even if such step is taught by Bair, would it have been obvious, within the meaning of 35 U.S.C. § 103, to have combined Bair with Mukhopadhyay in such a way as to result in the instant claimed subject matter.

Initially, we note that the examiner's assertion that it would have been obvious to combine the references "because they both are directed to data storing in one or more databases" (answer-page 4), is suspect for we agree with appellants that "[t]he fact that two references are in the same or analogous fields is a requirement in combining references under 35 USC 103 but is not a reason for combining references" (brief-page 6).

At page 10 of the answer, the examiner appears to take the view that appellants are making a nonanalogous art argument here, but this is not so. Appellants are not necessarily contending

that the applied references are not analogous. Rather, they are merely pointing out, and we agree, that just because two references may be related in some manner, as both being directed to data storage in the instant case, this does not, per se, provide a reason for combining the references, especially in a manner which would result in the claimed subject matter, unless there is some other reason for making the combination.

More importantly, Bair simply does not teach or suggest the claimed step of generating a user customized document. The portions of Bair indicated by the examiner, in column 8, merely describe the viewing of a patient's chart and the access, by a user, of other areas of the patient's chart, via a plurality of icons, but we find nothing therein suggestive of the claimed step of generating a user customized document which incorporates a portion of discovery information recorded in the SOR database.

It may be, in a broad sense, that Bair teaches the generation of a user customized document, in the sense that displays and reports are created for aggregating data from patient treatment results and a user chooses among patient progress indicators (see Bair's abstract), but, even if this is so, it is hard to see how this "customized document" may be said to incorporate at least a portion of the discovery information

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recorded in the SOR database, as required by the instant claim. The "discovery information" must define data and sources of the data for a data warehouse or data mart. It does not appear that this is the case in Bair.

Now, the examiner may say that it is Mukhopadhyay, and not Bair, which is relied on for the teaching of the claimed "discovery information," but this still does not explain how or why the artisan would employ a broad teaching, by Bair, of some user-generated customized document and then, without any suggestion to do so, incorporate at least a portion of Mukhopadhyay's discovery information recorded in an SOR database into that user-generated document.

The examiner's position, in a nutshell, is that Bair's individual patient's electronic chart or record corresponds to the claimed customized document.

Yet, even if we accept that a user in Bair may "customize" a document, by adding a new patient record, highlighting a patient's record, or deleting a patient's record, the examiner has not adequately explained how this equates to a document that is customized by "incorporating at least a portion of the discovery information recorded in the SOR database," nor, more importantly, does the examiner convincingly show why, or how, a

skilled artisan would have employed Bair's teaching of adding, deleting, or highlighting a patient's electronic chart or record, in Mukhopadhyay's system for capturing and propagating changes from an operational database to data marts, in such a manner as to result in the instant claimed subject matter.

The examiner indicates, at page 5 of the answer, that the references would have been combined "because that would have allowed users of Mukhopadhyay's capturing and propagating changes from an operational database to data marts to control which relative combinations of individual patient's database satisfies his or her needs as suggested by Bair...[col 3, see 41-46]. We do not see how this portion of Bair helps the examiner's case since it indicates that rules are set at a host site and are fixed unless the host management makes a determination that a rule needs to be changed. Thus, this portion of Bair appears to indicate that a change may be made by a host management, but not by a user. Accordingly, this would not appear to suggest the claimed generation of a user customized document in any event. But, more so, this cited portion of Bair does nothing, in our view, to suggest why, or how, the skilled artisan would have sought to combine Bair with Mukhopadhyay.

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Accordingly, since the examiner has not convincingly shown that the skilled artisan would have generated a user customized document incorporating at least a portion of the discovery information recorded in the SOR database in Mukhopadhyay, we will not sustain the rejection of claims 1-21 under 35 U.S.C. § 103.

The examiner's decision is reversed.

REVERSED

Errol A. Krass

ERROL A. KRASS)
Administrative Patent Judge)

Anita Pelleman Gross

ANITA PELLMAN GROSS)
Administrative Patent Judge)

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APPEALS AND
INTERFERENCES

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